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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79123938
Applicant	Wild Candy Pty Ltd
Applied for Mark	SNEEZING BABY PANDA
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I. INTRODUCTION

Applicant Wild Candy Pty Ltd hereby appeals from the Examining Attorney's partial refusal to register its U.S. Application Serial No. 79123938 (the "Application") for the mark SNEEZING BABY PANDA (the "Mark") in Classes 9, 16, 21, 25, 28, 35 and 41, based upon Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), on the stated ground that Applicant's mark SNEEZING BABY PANDA merely describes an ingredient, quality, characteristic, function, feature, purpose or use of Applicant's goods and services in those classes, and from the Examining Attorney's refusal to register based on supposed failure to respond to a requirement for additional information pursuant to Trademark Rule 2.61(b), 37 C.F.R. §2.61(b).

II. PROCEDURAL HISTORY

On September 13, 2012, the World Intellectual Property Organization ("WIPO") issued to Applicant International Registration No. 1144816 for its mark SNEEZING BABY PANDA in International Classes 3, 5, 9, 16, 21, 25, 28, 30, 35 and 41.

Applicant's extension of protection to the United States under this International Registration, with an effective filing date of September 13, 2012, was received by the USPTO from WIPO's International Bureau on January 17, 2013. There followed an exceptionally convoluted examination process, summarized as follows.

On January 30, 2013, the Examining Attorney issued a first, nonfinal office action partially refusing registration, as to International Classes 9, 16, 25, 35 and 41 only, on the stated ground that Applicant's mark SNEEZING BABY PANDA merely describes an ingredient, quality, characteristic, function, feature, purpose or use of Applicant's goods and services in

these classes, citing Trademark Act Section 2(e)(1), requiring amendments to the identification of goods and services, and requiring additional information pursuant to Trademark Rule 2.61(b).

On May 1, 2013, Applicant filed a response to the first office action (the “First Response”) submitting written argument against the partial refusal, submitting proposed amendments to the identification of goods and services, and submitting additional information about the applied for goods and services.

On May 31, 2013, the Examining Attorney issued a second, final office action (the “Second Office Action”), maintaining the partial refusal to register as to International Classes 9, 16, 25, 35 and 41, and requiring additional information regarding the applied for goods and services in Classes 3, 5, 21, 28 and 30.

On October 11, 2013, Applicant filed an appeal, pertaining to Classes 9, 16, 25, 35, 41, from the Examining Attorney’s final office action issued May 31, 2013, and simultaneously filed a request for reconsideration in response to such final office action (the “Second Response”), presenting further argument against the refusal and providing further additional information.

On October 12, 2013, the Board issued an order which instituted the appeal, suspended action thereon in view of the filing of the request for reconsideration, and remanded to the Examining Attorney to consider the request for reconsideration.

On November 14, 2013, the Examining Attorney issued a third, nonfinal office action (the “Third Office Action”), newly refusing registration as to International Classes 21 and 28 on the stated ground that the Mark merely describes an ingredient, quality, characteristic, function, feature, purpose or use of Applicant’s goods in these classes, maintaining the refusal to register as to Classes 9, 16, 25, 35 and 41, and requiring additional information regarding all applied for goods and services except those in Classes 3, 5 and 30.

On April 15, 2014, Applicant filed a response to the third, nonfinal office action (the “Third Response”) submitting written argument against the refusals, and submitting further additional information about its applied for goods and services.

Thereafter, on May 21, 2014, the Examining Attorney issued a fourth, final office action (the “Fourth Office Action”) maintaining the final refusal to register as to Classes 9, 16, 25, 35 and 41, making the refusal as to Classes 21 and 28 final, and making final the requirement to provide additional information regarding all applied for goods and services except those in Classes 3, 5 and 30.

On September 23, 2014, Applicant filed a request for reconsideration in response to such fourth, final office action, requesting that the Examining Attorney return the application to the Board, so that proceedings in the appeal be resumed and Applicant have the opportunity to file its appeal brief in the appeal pertaining to Classes 9, 16, 25, 35, 41. Regarding the Examining Attorney’s final refusal pertaining to Classes 21 and 28, Applicant pointed out that these classes were not made the subject of the pending appeal because the refusals as to these two classes had not been made final at the time Applicant filed the appeal.

On October 14, 2014, the Examining Attorney issued a reconsideration letter acknowledging that the appeal as filed pertained to Classes 9, 16, 25, 35 and 41, and did not include Classes 21 and 28, and confirming that if Applicant wishes to file an appeal to resolve comprehensively the outstanding refusal and requirements in connection with the goods in Classes 21 and 28 by November 21, 2014, the Examining Attorney would have no objection to consolidating the appeals.

On October 28, 2014, the Board issued an order adding Classes 21 and 28 to the instant appeal, at Applicant's request, and allowing Applicant until 60 days from the mailing date of said order to file its appeal brief herein.

III. ARGUMENT

For the reasons set forth below, Applicant respectfully submits that the Mark, for the applied for goods and services in Classes 9, 16, 21, 25, 28, 35 and 41, does not merely describe an ingredient, quality, characteristic, function, feature, purpose or use of Applicant's goods or services in those classes, that the Section 2(e)(1) refusal should therefore be withdrawn, as should the requirement for additional information pursuant to Trademark Rule 2.61(b).

A. APPLICANT'S RESPONSES TO THE EXAMINING ATTORNEY'S REQUESTS FOR ADDITIONAL INFORMATION HAVE BEEN AMPLE AND SATISFY WHAT IS REASONABLY NECESSARY TO THE PROPER EXAMINATION OF THE APPLICATION IN CONFORMITY WITH TRADEMARK RULE 2.61(b).

In its first three responses to the Examining Attorney's office action requests for additional information, Applicant has provided quite ample information and materials about its business and its intended use of the Mark in U.S. commerce on or in connection with the applied for goods and services. This additional information, together with the information and materials about Applicant's business which the Examining Attorney has put in evidence in his office actions, wholly satisfy what is reasonably necessary to the proper examination of the application in conformity with Trademark Rule 2.61(b).

1. Additional Information Submitted in First Response

In its First Response, Applicant provided the following information:

“Applicant submits, as its website materials submitted in evidence by the Examining Attorney attest, that it is a film maker specializing in documentary film making and distribution. Several years ago Applicant was filming in the Wolong Panda Breeding Centre in China’s Sichuan province. A female panda was munching a piece of bamboo bread, oblivious of the fact her six week old son was hungry too. Clearly frustrated as well as starving, the tiny panda cub suddenly let loose with his now infamous sneeze. The moment was recorded on film (the “Film Footage”) and “Sneezing Baby Panda” was born. A television program created and produced by Applicant entitled “Little Pandas – The New Breed” featured the Film Footage. The Film Footage was unlawfully reproduced from this television program and unlawfully uploaded onto the Internet and has since that time gone viral. Applicant is the exclusive copyright owner in the Film Footage, and has licensed the Film Footage in the United States and elsewhere.

“Applicant has used the applied for mark in Australia and elsewhere since the broadcast of the television program, and owns and operates the website www.sneezingbabypanda.com referenced by the Examining Attorney. Currently only t-shirts bearing the mark are available for purchase online, but Applicant intends to extend the range of merchandise available for purchase in the United States and elsewhere. Such merchandise is not intended to be limited in subject matter to pandas, but rather will feature animals generally, nature and the environment.

“The registration of the applied for mark by Applicant will not preclude others from making descriptive fair use of the term “Sneezing Baby Panda” to describe Applicant’s Film Footage. That said, however, Applicant’s exclusive ownership of the Film Footage and extensive and substantially exclusive use of the mark SNEEZING BABY PANDA

throughout Australia, the United States, and worldwide, means that the mark is capable of distinguishing Applicant's applied for goods and services from the goods and services of competitors. Indeed, given the fame of the Film Footage and its association with Applicant as the film maker, there is no reason why another trader would wish to use the same mark on the same or similar goods or services unless with improper motive."

In specific response to the Examining Attorney's request for additional information about the applied for goods and services, Applicant submitted that *"its applied for goods and services, as amended, do not necessarily have to do with pandas, but rather may feature animals generally, nature and the environment."*

2. Additional Information Submitted in Second Response

In its Second Response, Applicant pointed out that:

"Since the application is a Madrid System extension of protection based on Section 66(a) of the Trademark Act, founded on Applicant's intent to use the mark in United States commerce, Applicant submits that its previous response to office action, together with the information the Examining Attorney has already made of record, is sufficient to permit proper examination of the application. The Examining Attorney's renewed request merely parrots boilerplate office action verbiage appropriate to a use-based application under Section 1(a), but inappropriate to examination of an application based on bona fide intent to use in U.S. commerce, e.g., under Sections 1(b) or 66(a)."

Notwithstanding this, Applicant volunteered additional helpful information:

"Nevertheless, Applicant hereby volunteers the additional information for the Examining Attorney's consideration attached to this response consisting of various third party webpages corroborating and attesting to the fame of the Film Footage and

Applicant's association with the mascot for its applied for goods and services dubbed SNEEZING BABY PANDA. This additional information and submitted materials, together with the evidence and submissions of record, more than amply demonstrate the capacity of SNEEZING BABY PANDA to serve as a non-descriptive source indicator for Applicant's goods and services, and Applicant's entitlement to exploit same as a trademark in United States commerce, as it intends to do."

3. Additional Information Submitted in Third Response

In its Third Response, Applicant provided even more highly concrete information about its business and its intended use of the Mark in U.S. commerce:

"As Applicant pointed out in its response, filed May 1, 2013, to the Examining Attorney's first office action, and as its website materials submitted in evidence by the Examining Attorney attest, Applicant is a film maker specializing in documentary film making and distribution. Several years ago Applicant was filming in the Wolong Panda Breeding Centre in China's Sichuan province. A female panda was munching a piece of bamboo bread, oblivious of the fact her six week old son was hungry too. Clearly frustrated as well as starving, the tiny panda cub suddenly let loose with his now infamous sneeze. The moment was recorded on film (the "Film Footage") and "Sneezing Baby Panda" was born. A television program created and produced by Applicant entitled "Little Pandas – The New Breed" featured the Film Footage. The Film Footage was unlawfully reproduced from this television program and unlawfully uploaded onto the Internet and has since that time gone viral. Applicant is the exclusive copyright owner of the Film Footage, and has licensed the Film Footage in the United States and elsewhere.

“In more recent developments, Applicant submits that production of its feature film “Sneezing Baby Panda: The Movie” (the “Movie”) has been completed, that release of the film is slated for May 2014, and that the DVD/VoD of the film will be released and widely distributed in the United States by Viva Pictures LLC, based in Los Angeles, Applicant’s North American distributor. (See promotional flyer attached and submitted as a part of this response to office action.)

“Applicant further submits that it is currently in discussions with potential partners in the United States for a children’s environmentally themed television series with Sneezing Baby Panda as one of the series characters, plus electronic games and mobile device apps in a similar vein, as that in connection with the aforementioned film premiere has set upcoming meetings next month at the Cannes Film Festival from May 14 through 25, 2014, with merchandise licensing companies including for merchandise promotion, marketing, distribution and sale in the United States. These current marketing efforts exemplify the commercial intentions and activities Applicant has represented in its previous responses. These licensing and marketing efforts corroborate Applicant’s good faith intent to use “Sneezing Baby Panda” as a trademark in the U.S., and demonstrate that Applicant’s intended use of the trademark transcends the use of “Sneezing Baby Panda” as a single film title.”

4. Summary

Trademark Manual of Examining Procedure §814 provides: “Sometimes, it is necessary for the examining attorney to request additional information from an applicant in order to examine the application properly, pursuant to Trademark Rule 2.61(b), 37 C.F.R. §2.61(b). If

the applicant does not comply with a requirement for additional information, registration may be refused.”

In the present case, Applicant has complied with the Examining Attorney’s requirement for additional information, providing quite ample information and materials about its business and its intended use of the Mark in U.S. commerce on or in connection with the applied for goods and services. This information and materials, together with the information and materials about Applicant’s business which the Examining Attorney has put in evidence in his office actions, satisfy what is reasonably necessary to the proper examination of the application in conformity with Trademark Rule 2.61(b).

Since the application under examination is a Madrid System extension of protection based on Section 66(a) of the Trademark Act, founded on Applicant’s bona fide intent to use the mark in United States commerce, the level of detail available to Applicant about the applied for goods and services, in the logical nature of things, cannot be as concrete as would be the case in a use-based application under Section 1(a). Applicant wishes to point out that the information and materials it has submitted wholly corroborate the *bona fides* of Applicant’s intent to use the mark in U.S. commerce, and the Examining Attorney has no basis to call into question such *bona fides*.

In his office actions, the Examining Attorney attempts to rely on In re Cheezwhse.com, Inc., 85 USPQ2d 1917 (TTAB 2008). However, that case is wholly distinguishable from the present case.

In Cheezwhse.com, Inc., the examining attorney issued final refusals to register on the grounds that applicant had failed to comply with a requirement for information under Trademark Rule 2.61(b). The Board noted that the Rule provides “[t]he examiner may require the applicant

to furnish such information and exhibits as may be *reasonably necessary to the proper examination of the application.*” Id. at 1918 (emphasis added).

The Board’s decision to affirm the refusal was based on the applicant’s intransigence and failure even to acknowledge the additional information requirement:

“In the first Office action, the Trademark Examining Attorney required applicant to provide information as to the geographic origin of applicant’s goods. In its response to the Office action, applicant failed to even acknowledge the requirement, much less comply with it. The Trademark Examining Attorney made the requirement final in the final Office action. In its appeal brief (the next paper applicant filed), applicant again failed to acknowledge the requirement. The Trademark Examining Attorney’s appeal brief reiterated the requirement. Applicant did not file a reply brief or otherwise respond to the requirement. In short, despite repeated requests and reminders, applicant did not comply with or even acknowledge the Trademark Examining Attorney’s requirement for information. In view thereof, the refusal to register based on applicant’s failure to comply with Trademark Rule 2.61(b) is affirmed.” Id. at 1919.

In the present case, Applicant has complied multiple times with the Examining Attorney’s repeated requirements for additional information, providing information and materials which wholly satisfy what is reasonably necessary to the proper examination of the application in conformity with Trademark Rule 2.61(b).

Therefore, the request for additional information made final in the Fourth Office Action should be withdrawn.

B. APPLICANT’S MARK IS NOT MERELY DESCRIPTIVE WITHIN THE MEANING OF SECTION 2(e)(1) OF THE TRADEMARK ACT OF THE APPLIED FOR GOODS OR SERVICES IN CLASSES 9, 16, 21, 25, 28, 35 and 41.

In his Third Office Action, the Examining Attorney raised for the first time a new issue relative to Classes 21 and 28, causing him to generate another nonfinal office action, superseding the previously issued final office action, and causing Applicant’s appeal to remain suspended.

Contending that the identified goods may feature images and/or information about a “sneezing baby panda” and may take the form/shape of a “sneezing baby panda”, the Examining Attorney refused registration under Section 2(e)(1) as to Classes 21 and 28 on the stated ground that the applied-for mark merely describes key features and/or characteristics of Applicant’s goods in those classes.

The identification of goods and services, as amended, in those classes is:

Class 21:

Mugs; beverage glassware; porcelain and earthenware not included in other classes, namely, sculptures, statues and works of art; containers for household and kitchen use; hair combs.

Class 28:

Games and playthings, namely, plush dolls, stuffed toy animals and board games; toys, namely, electronic learning toys, infant toys and hand-held units for playing electronic games for use with external display screen or monitor; gymnastic and sporting articles not included in other classes, namely, gymnastic apparatus, balls for sports and protective supports for shoulders and elbows.

The Examining Attorney's argument attempting to support this refusal essentially repeated his similar argumentation made in the previous office actions.

The Examining Attorney also contended that Applicant's Second Response did not contain new arguments against the refusal under Section 2(e)(1) in Classes 9, 16, 25, 35 and 41 on the stated ground that the applied-for mark the applied-for mark merely describes key features and/or characteristics of applicant's goods and services in those classes, and maintained this refusal.

The identification of goods and services, as amended, in those classes is:

Class 9:

Digital media, namely, pre-recorded CDs, DVDs, video cassettes, digital video discs, digital versatile discs and high definition digital discs featuring audio and visual content in the nature of exposed cinematograph films, theatrical performances and music; electronic games, namely, electronic game software, electronic game programs and downloadable electronic games via the Internet and wireless devices.

Class 16:

Paper, cardboard, and goods made from these materials, not included in other classes, namely, printed posters; photographs; stationery; printed instructional and teaching material except apparatus in the field of animals, nature and the environment; books, namely, children's books, comic books, coloring books, series of fiction books, series of non-fiction books in the field of animals, nature and the environment and educational books and coffee table books featuring animals, nature and the environment; brochures about animals, nature and the environment; publications, namely, magazines, hand-outs and workbooks in the field of animals, nature and the environment; printed event programs and souvenir programs concerning animals, nature and the environment; face and facial tissues of paper.

Class 25:

Clothing, namely, t-shirts, sweat shirts and jackets; footwear; headgear, namely, hats and caps.

Class 35:

Promotion of theatrical performances, concerts, cinematograph films and musical works for others.

Class 41:

Production of cinematograph films, television programs and documentary films; entertainment, namely, live music concerts and orchestra performances; electronic publication services, namely, digital video, audio, and multimedia publishing services regarding cinematograph films, theatrical performances and music; electronic publication of text and graphic works of others on CD, DVD and on-line featuring animals, nature and the environment; entertainment services, namely, theatrical and musical floor shows provided at performance venues.

In light of the above amended identification of goods and services, Applicant wishes to emphasize the governing legal principles determinative of whether or not an applied for mark merely describes a feature of an applicant's applied for goods and services under Trademark Act Section 2(e)(1).

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the goods or services at issue. However, a mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The question of whether a particular term is merely descriptive is not decided in the abstract. The test is not whether prospective consumers can guess what an applicant's goods or services are after seeing that applicant's mark alone. Rather, the determination of whether a mark is merely descriptive is considered in relation to the identified goods and services. In re Abcor Dev. Corp., 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b). A trademark is merely descriptive only if it directly gives accurate or distinct knowledge of the characteristics of those goods or services. Blisscraft of Hollywood v. United Plastics Company, 294 F.2d 694, 131 U.S.P.Q. 55 (2nd Cir. 1961).

The proper test in determining whether a mark is merely descriptive is to consider the mark in relation to the goods and services applied for, the context in which the mark would be used, and the significance that the mark is likely to have on the average consumer encountering the goods in the marketplace. This determination must be made specifically in relation to the goods or services for which registration is sought. In re Omaha National Corp., 819 F.2d 1117, 2 U.S.P.Q.2d 1859 (Fed. Cir. 1987).

For purposes of Trademark Act Section 2(e)(1), Applicant's mark "Sneezing Baby Panda" does not describe an ingredient, quality, characteristic, function, feature, purpose or use of the identified goods or services in Classes 9, 16, 21, 25, 28, 35 or 41.

Here, the mark "Sneezing Baby Panda" does not describe a feature of the goods or services claimed. The bulk of Applicant's goods and services in Classes 9, 16, 21, 25, 28, 35 and 41, as amended, have nothing intrinsically to do with pandas, though some of those goods and services specifically have to do with animals, nature and the environment. Therefore, the mark should not be regarded as merely descriptive.

As is obvious from the amended identification of goods and services, the goods and services of Applicant may be anchored in the Movie as well as the Film Footage, promoting the mark “Sneezing Baby Panda” as an indicator of source, but those goods and services, on the face of the identification, do not consist of the Film Footage itself, even though some of those goods and services may derive from it, nor does Applicant aim to protect “Sneezing Baby Panda” as a trademark merely by use of the term in the title of the Movie.

It is crystal clear from the Examining Attorney’s remarks, Applicant’s submissions, and the evidence of record that there is one, and only one, “Sneezing Baby Panda”. The mark “Sneezing Baby Panda” is not a term descriptive of pandas or baby pandas in general. The Examining Attorney and Applicant agree that “Sneezing Baby Panda” refers to one unique baby panda at one point in time, the panda cub who let loose with his famous sneeze memorialized in the Film Footage. “Sneezing Baby Panda,” soon to be the star of the Movie, has a unique referent. As pointed out in previous responses, the subject matter content of some of Applicant’s goods or services may or may not include pandas, but they may also have to do with other species of animals, nature and the environment, and the unique referent “Sneezing Baby Panda” is intended to be used by Applicant as a source indicator for its family of goods and services so branded. Therefore, the mark should not be regarded as merely descriptive, and the Examining Attorney’s comments should be reviewed in this context.

The Examiner Attorney has contended in his Third Office Action:

“In this case, the proposed mark “Sneezing Baby Panda” merely describes pre-recorded CDs and DVDs and other media, printed matter, clothing, promotional services, entertainment services and publishing services featuring images and/or information about

an extremely young black-and-white mammal caught in the act of making a sudden violent spasmodic audible expiration of breath through the nose and mouth.”

Applicant pointed out in its First Response that the Examining Attorney had submitted no evidence which supports this contention. In response, the Examining Attorney stated:

“However, contrary to applicant’s comment, the sample dictionary definitions and Internet printouts from applicant’s website attached to the Office Action mailed January 30, 2013 unambiguously display information and videos about a “tiny panda cub [that] let loose with [a] now infamous sneeze” and “sneezing pandas” while also showing a “t-shirt featuring a freeze frame from the original video clip” of “[t]hat sneezing moment which sent mother panda into orbit!” Therefore, inasmuch as applicant has turned a blind-eye and casually dismissed the evidence of record, applicant’s argument is not persuasive.

“Material obtained from applicant’s website is acceptable as competent evidence.”

To be clear, Applicant did not previously and does not now object to the Examining Attorney’s reference to its website in this regard. Moreover, Applicant finds the Examining Attorney’s charge that it “has turned a blind-eye and casually dismissed the evidence of record” odd given Applicant’s previous responses. Applicant maintains that the referenced information and materials from Applicant’s website in fact do not support the refusal.

Applicant has used the applied for mark “Sneezing Baby Panda” in Australia and elsewhere since the broadcast of the television program, and owns and operates the website www.sneezingbabypana.com referenced by the Examining Attorney. As indicated in Applicant’s Second Response, currently only t-shirts bearing the mark are available for purchase online, but Applicant intends to extend the range of merchandise available for purchase in the United States and elsewhere, and its current commercial marketing activities and business discussions corroborate that

intent. As stated in the Second Response, such merchandise is not intended to be limited in subject matter to pandas, but rather will feature animals generally, nature and the environment.

The Examining Attorney noted that Applicant considers the refusal unwarranted because the identified goods are not intended to be limited in subject matter to pandas, but rather will feature animals generally, nature and the environment, yet then argued in his Third Office Action:

“However, ‘[a] mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.’

“In this case, the wording “‘Sneezing Baby Panda’” describes at least one aspect of the identified goods and services; namely, pre-recorded media, printed matter, clothing, promotional services, entertainment services and publishing services featuring images and/or information about a sneezing young panda bear.

“What’s more, inasmuch as applicant concedes that ‘the term “‘Sneezing Baby Panda’” may be regarded as descriptive of the film footage” featured and promoted in connection with its goods and services, consumers will immediately recognize and perceive the nature of the products and services.”

The Examining Attorney’s statement here blindly ignores Applicant’s submission in its first three responses that its merchandise under the “Sneezing Baby Panda” mark is not intended to be limited in subject matter to pandas, but rather will feature animals generally, nature and the environment. Thus, the mark “Sneezing Baby Panda” does not describe “at least one aspect of the identified goods and services” because those goods or services may or may not involve pandas, as the amended identification of goods and services makes clear. Again, the unique one-off baby panda referenced by the mark “Sneezing Baby Panda” is intended to be used as a source indicator for the applied for goods and services, in the nature of a mascot or flag bearer.

As emphasized in Applicant's first three responses, the registration of the applied for mark by Applicant will not preclude others from making descriptive fair use of the term "Sneezing Baby Panda" to describe Applicant's Film Footage. That said, however, Applicant's exclusive ownership of the Film Footage and extensive and substantially exclusive use of the mark "Sneezing Baby Panda" throughout Australia, the United States, and worldwide, means that the mark is capable of distinguishing Applicant's applied for goods and services from the goods and services of competitors. Indeed, given the fame of the Film Footage and its association with Applicant as the film maker, and the upcoming release of the Movie, which has already been highly publicized in industry media, there is no reason why another trader would wish to use the same mark on the same or similar goods or services unless with improper motive.

The Examining Attorney further contended in his Third Office Action that:

"In this case, the combination of the descriptive words SNEEZING, BABY and PANDA creates no incongruity or unique commercial impression apart from that of the previously-stated descriptive connotation, and no imagination is required to understand the nature of the goods and services. Accordingly, the mark is merely descriptive."

While the term "Sneezing Baby Panda" may be regarded as descriptive of the Film Footage, or the Movie, in the sense that it is the title of a copyrighted work, and the title is closely associated with Applicant as the maker of the Film Footage and the Movie, the trademark "Sneezing Baby Panda" describes Applicant as the source of its applied for goods and services, akin to the way a mascot might identify a sports team, but it does not describe those goods or services.

Moreover, Applicant maintains as stated in its previous responses that even if the terms SNEEZING, BABY and PANDA might be regarded as descriptive of the Film Footage, the

composite “Sneezing Baby Panda” in combination, used in connection with Applicant’s goods and services as amended, are not descriptive.

Assuming arguendo that the separate terms contained in Applicant’s mark might be regarded as descriptive, a mark comprising a combination of descriptive components is registrable if the combination of terms creates a unitary mark. In re Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968); In re Shutts, 217 USPQ 363 (TTAB 1983); TMEP Section 1209.03(d). Applicant reiterates that its compound mark “Sneezing Baby Panda” is not descriptive, because the combination of terms, composed of three two-syllable words, possesses a special rhythmic quality creating a unitary mark.

The compound mark “Sneezing Baby Panda” is not descriptive. If at all, the mark is suggestive of, rather than descriptive of, the Applicant’s goods and services. In considering whether a mark is merely descriptive, the question is whether the mark “only” tells the potential purchaser what the goods or services are, their function, their characteristics, their use, or their ingredients. Here, Applicant’s mark does not “only” describe or “only” tell potential purchasers about the nature, function, characteristics or purpose of Applicant’s goods or services in Classes 9, 16, 25, 35, 41, or in Classes 21 and 28, because “Sneezing Baby Panda” in connection with the goods and services applied for in those classes is an incongruous expression, *see* Blisscraft of Hollywood v. United Plastics Company, 294 F.2d 694, 131 U.S.P.Q. 55 (2nd Cir. 1961) and Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968).

Applicant’s mark is a word combination that is not readily recognizable as describing a particular characteristic, purpose or feature of applicant’s goods with any degree of specificity. The mark does not convey any immediate and unambiguous meaning.

The three-word compound mark creates ambiguity. In consequence thereof, actual and prospective consumers who encounter the mark in connection with Applicant's goods or services in the marketplace would have to engage in a multi-stage reasoning process, involving pausing, reflecting and then speculating on the significance of the combined designation, in order to understand how it relates to Applicant's goods.

Thus, the mark "Sneezing Baby Panda" for Applicant's goods and services, as amended, is not merely descriptive of any characteristic, purpose or feature of Applicant's goods and services in the relevant classes. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the refusal of registration on grounds of descriptiveness.

Applicant wishes to emphasize that it is the policy of the U.S. Patent and Trademark Office to resolve any doubt as to descriptiveness in favor of Applicant. In re Women's Publishing Co., 23 USPQ2d 1876, 1878 (TTAB 1992) (citing In re Merrill, Lynch, Pierce, Fenner & Smith, Inc., 822 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987)). The distinction between merely descriptive and suggestive is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985). Accordingly, to the extent there may be any doubt as to whether an Applicant's mark is merely descriptive or suggestive, such doubt is resolved, in accordance with the Board's policy, in favor of the applicant by allowing publication of the mark for opposition.

Upon publication of Applicant's mark, anyone who believes that they would be damaged by the registration of the mark will have the opportunity to file an opposition thereto. Such an entity may well be in a stronger position to make the case for competitive need for use of this term than is the Office in an ex parte context. In re Merrill Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Further, anyone who believes he or she will be injured by

the registration of “Sneezing Baby Panda” “will have an opportunity to develop a factual record upon which the question of descriptiveness could be adjudicated with more confidence than it can be on the basis of *a priori* assumptions.” In re Waverly Inc., 27 USPQ2d 1620, 1624 (TTAB 1993), citing In re Merrill Lynch, Pierce, Fenner & Smith, 828 F.2d at 1571.

Accordingly, Applicant respectfully requests that the Board withdraw the Examining Attorney’s refusal under Section 2(e)(1) of the Trademark Act, and allow the Application to proceed to publication.

IV. CONCLUSION

For the reasons set forth above, Applicant respectfully requests that the Board withdraw the Examining Attorney’s refusals under Section 2(e)(1) of the Trademark Act and Trademark Rule 2.61(b), and allow the Application to proceed to publication.

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Respectfully submitted,

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